

DOCKET NO. 00-BN-067 (STMJ01-00067)
U.S. SERIAL NO. 09/751,679
PATENT

REMARKS

Claims 1-7, 9-17, 19-23, and 25 were pending in this application.

Claims 1-7, 11-17, and 21-23 have been rejected.

Claims 9, 10, 19, 20, and 25 have been objected to.

Claim 25 has been amended as shown above.

Claims 1-7, 9-17, 19-23, and 25 remain pending in this application.

Reconsideration and full allowance of Claims 1-7, 9-17, 19-23, and 25 are respectfully requested.

I. ALLOWABLE CLAIMS

The Applicants thank the Examiner for the indication that Claims 9, 10, 19, 20, and 25 would be allowable if rewritten in independent form to incorporate the elements of their respective base claims and any intervening claims. Because the Applicants believe that the remaining claims in this application are allowable, the Applicants have not rewritten Claims 9, 10, 19, 20, and 25 in independent form.

II. OBJECTION TO CLAIMS

The Office Action objects to Claim 25 because of an informality in Claim 25. The Applicants have amended Claim 25 to correct the noted informality. The Applicants respectfully request withdrawal of the objection to the claims.

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III. REJECTION UNDER 35 U.S.C. § 103

The Office Action rejects Claims 1-7, 11-17, and 21-23 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,680,564 to Divivier et al. ("*Divivier*") in view of U.S. Patent No. 5,922,065 to Hull et al. ("*Hull*") and in further view of U.S. Patent No. 6,480,938 to Vondran, Jr. ("*Vondran*"). This rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (*MPEP* § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992)). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)). Only when a *prima facie* case of obviousness is established does the burden shift to the Applicant to produce evidence of nonobviousness. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993)). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the Applicant is entitled to grant of a patent. (*In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985)).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993)). To establish a *prima facie* case of

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obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on the Applicant's disclosure. (MPEP § 2142).

The Office Action acknowledges that *Divivier* fails to disclose using a "stop bit" in a "highest syllable" of an "instruction" to determine whether "every syllable" of the instruction "has been stored" in a buffer as recited in Claims 1, 11, and 21. (*Office Action, Page 4, Last paragraph*). The Office Action then asserts that *Hull* discloses these elements of Claims 1, 11, and 21 and that it would be obvious to combine *Divivier* and *Hull*. (*Office Action, Page 4, Last paragraph – Page 5, First paragraph*).

Hull recites a processor that encodes a set of the most useful instruction sequences into a long word instruction format. (*Abstract*). Instructions are grouped into bundles, where each bundle includes three slots for three different instructions and a stop bit. (*Col. 3, Lines 52-55*). The stop bit indicates whether the instructions in one bundle continue into another bundle. (*Col. 4, Lines 11-19*). The instructions in the slots of a group are executed in the order of the slots. (*Col. 4, Lines 61-67*).

Hull simply recites that a stop bit is used to separate different groups of instructions. If the stop bit has one value, the instructions in a group are combined with the instructions in a

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neighboring group. If the stop bit has another value, the instructions in one group are not combined with the instructions in the neighboring group. *Hull* lacks any mention that the stop bit is used with multiple "syllables" of a single instruction. More specifically, *Hull* lacks any mention that the stop bit is used to identify the highest "syllable" of a single instruction. Moreover, in *Hull*, the instructions in a group are executed sequentially or serially. Execution of one instruction in the group occurs after execution of a prior instruction in the group. *Hull* lacks any mention that multiple syllables of a single instruction are transferred into one or more "issue lanes" based on a determination made using the "stop bit."

For these reasons, the Office Action has not established a *prima facie* case of obviousness against Claims 1, 11, and 21 (and their dependent claims). Accordingly, the Applicants respectfully request withdrawal of the § 103 rejection and full allowance of Claims 1-7, 11-17, and 21-23.

IV. CONCLUSION

The Applicants respectfully assert that all pending claims in this application are in condition for allowance and respectfully request full allowance of the claims.

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SUMMARY

If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at wmunck@davismunck.com.

The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any extension of time fees) or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

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Date: July 27, 2005



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